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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,137	09/07/2001	Satoshi Makino	106145-00022	7787

7590 10/02/2003

Arent Fox Kintner Plotkin & Kahn
1050 Connecticut Avenue NW Suite 600
Washington, DC 20036-5339

EXAMINER

FISCHER, JUSTIN R

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-9

Office Action Summary

Application No.

09/926,137

Applicant(s)

MAKINO, SATOSHI

Examiner

Justin R Fischer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-11 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 8-13 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 5 is/are allowed.
- 6) ☒ Claim(s) 6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 8.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 1 and 2 are cancelled per Amendment B on July 28, 2003.

Election/Restrictions

2. Newly submitted claims 8-13 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: independent claim 8 defines a tubeless tire in which (i) a most inner layer covers the entire inside of the inner liner layer, (ii) the area of the non adhesion part is larger than the area of said adhesion parts, and (iii) the most inner layer is stuck to said inner liner layer in the vicinity of the bead portion. The previous claims, on the other hand, do not require either one of these limitations and further require a specific orientation of the most inner layer (e.g. has a form of a pleat or contains openings in the non adhesion part). As such, it is evident that the respective claims contain a unique and separate means for establishing patentability. Regarding "unity of invention", the claims do not contain a special technical feature that defines a contribution over the prior art as a whole. In this instance, Kawaguchi and Harrington disclose a pneumatic tire construction having an inner liner layer and a most inner layer, wherein adhesion and non-adhesion portions exist between the respective layers. It is additionally noted that the original disclosure does not provide support to require "the area of said non adhesion part is larger than the area of said adhesion parts" and as such, the language would constitute new matter.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8-13 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of the noted claims, the following language appears- "said adhesion parts include at least one additional adhesion part to which is affixed to the non adhesion part that is not stuck to said inner liner layer, and wherein the adhesion part is formed in a line or dot.". In a similar manner to the 112, 2nd Paragraph rejection in Paper Number 6, Paragraph 5, this language does not provide a clear and concise understanding of the claimed invention. It is unclear if applicant intends the language to suggest that the non adhesion part is actually partially adhered to the inner liner layer (in the form of lines or dots) or if the adhesion part is formed by discontinuous bonding (in the form of lines or dots) as opposed to be being bonded continuously to the inner liner layer. It is noted that newly presented claim 8 includes a new limitation that defines the non-adhesion part as having second adhesion parts in the form of lines or dots (analogous to defining the non adhesion part as being discontinuously bonded). This language, though, is

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different from the language presented in claims 6 and 7 and as such, it is unclear what the aforementioned language is intended to define. If applicant intends this embodiment to be described, it is suggested that the language of claim 8 be incorporated into claims 6 and 7 without the introduction of new matter. If not, applicant asked to clarify the language of the claimed invention.

Allowable Subject Matter

5. Claims 3 and 5 are allowed. The following is a statement of reasons for the indication of allowable subject matter: While the prior art references of record suggest a tire construction having an inner liner layer and a most inner layer such that adhesion parts and no-adhesion parts existed between the respective layers, none of the references of record disclosed such a characteristic in combination with the most inner liner layer either (a) being in the form of a pleat (folds) or (b) having openings at regular intervals in the non adhesion part in order to provide enhanced puncture resistance.

6. Claims 6 and 7 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. The reasons for indicating these claims allowable are analogous to the reasons presented in the previous paragraph.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R Fischer** whose telephone number is **(703) 605-4397**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703) 308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Justin Fischer

September 30, 2003


JEFF H. AFTERGUT
PRIMARY EXAMINER
GROUP 1300